

Serial No. 10/047,878  
Page 5

### REMARKS

This amendment is in response to the Final Office Action mailed on May 25, 2004 wherein Claims 1-12 and 14-18 were rejected. Claims 1, 9, and 17 have been amended, Claims 1-12 and 14-18 remain pending.

#### Claim Rejections Under 35 USC § 102 and 103

On page 2 of the Office Action, the Examiner rejected Claims 1-3 under 35 USC § 102 as being anticipated by Jarczyński. On page 3 of the Office Action, Claim 4 was rejected under 35 USC § 103 as being unpatentable over Jarczyński, Claim 5 was rejected under 35 USC § 103 as being unpatentable over Jarczyński in view of Yamamoto. On page 4 of the Office Action Claim 6 was rejected under 35 USC § 103 as being unpatentable over Jarczyński in view of Darby et al. On page 5 of the Office Action Claims 7 and 8 were rejected under 35 USC § 103 as being unpatentable over Jarczyński in view of Grennan et al. On page 6 of the Office Action Claims 9-12 were rejected under 35 USC § 103 as being unpatentable over Yamamoto in view of Jarczyński. On page 7 of the Office Action Claims 15 and 16 were rejected under 35 USC § 103 as being unpatentable over Yamamoto in view of Jarczyński and Grennan et al. On page 8 Claims 14 and 17 were rejected under 35 USC § 103 as being unpatentable over Yamamoto in view of Jarczyński and Darby et al.

Applicants have amended Claims 1, 9, and 17 to better describe the present invention. With reference to Claims 1, 9, and 17, Jarczyński propels fluid through a rotor of an electric motor using a pump 30 and heat exchanger, as seen in Figure 1 and disclosed in column 5, lines 29-34 ("externally pumped coolant"). The present claimed invention utilizes centrifugal force to propel the coolant through the rotor and motor shaft. The use of "pumped" coolant requires a coolant pump and is fundamentally different than the use of centrifugal force in the present invention. Jarczyński does not teach or suggest the present claimed invention.

With reference to Claim 4, Applicants reject the Official Notice regarding the use of a permanent magnet in and electric motor request support for the Examiner's assertion.

With reference to Claim 5, Jarczyński and Yamamoto ("supplied with pressure from an external oil source") both disclose externally pumped coolants and not the use of centrifugal

Serial No. 10/047,878

Page 6

force to propel coolant through a rotor and motor shaft. Jarczynski and Yamamoto, singly or in combination, do not teach or suggest the present invention.

With reference to Claim 6, Darby et al. discloses cooling using pressured gas and not a nongaseous liquid coolant, as disclosed in column 2, lines 31-35 and column 3, lines 10-20. A fan 22 forces gas through the rotor of Darby et al. Darby et al. is completely silent with respect to a nongaseous liquid coolant propelled by centrifugal force through a rotor and motor shaft. Furthermore, the combination of Jarczynski and Darby et al. would generate a nonfunctioning systems as the fan or Darby et al. does not have the capability to pressurize oil in an electric motor. The CCPA and Federal Circuit have consistently held that an obviousness rejection based on a modification that destroys, the intent, purpose or function of the invention disclosed in a reference is not proper and a prima facie case of obviousness cannot be properly made. *In re Gordon* 733 F.2d 900, 221.

With reference to Claims 9-12, Jarczynski and Yamamoto ("supplied with pressure from an external oil source") both disclose externally pumped coolants and not the use of centrifugal force to propel coolant through a rotor and motor shaft. Jarczynski and Yamamoto, singly or in combination, do not teach or suggest the present invention.

With reference to Claims 15 and 16, Grennan discloses an air cooled dynamometer, as disclosed in column 2, lines 29-50. Vanes act as impellers to propel the air, as disclosed in column 5, lines 7-15. Grennan is completely silent with respect to a nongaseous liquid coolant propelled by centrifugal force through a rotor and motor shaft. Furthermore, the combination of Grennan, Jarczynski and Yamamoto would generate a nonfunctioning systems as the vanes of Grennan do not have the capability to pressurize oil in an electric motor. The CCPA and Federal Circuit have consistently held that an obviousness rejection based on a modification that destroys, the intent, purpose or function of the invention disclosed in a reference is not proper and a prima facie case of obviousness cannot be properly made. *In re Gordon* 733 F.2d 900, 221.

Serial No. 10/047,878

Page 7

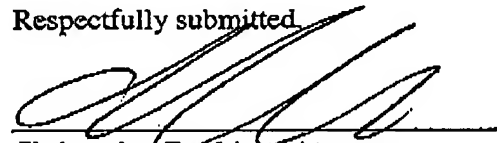
The Examiner has failed to explain how and why the claimed subject matter is rendered unpatentable over the prior art and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on. If the Examiner relies on personal knowledge that the apparatus of the present invention is obvious, Applicants respectfully request support for this assertion in the form of an affidavit that shall be subject to contradiction or explanation by the affidavits of the Applicants and other persons under 37 CFR 1.104(d)(2).

Conclusion

The entire Office Action, dated May 25, 2004, has been carefully reviewed, and this response is submitted as being fully responsive thereto. In view of the preceding remarks, Applicants respectfully submit that Claims 1-12 and 14-18 are in condition for allowance and respectfully request such action at the Examiner's earliest convenience. If the Examiner believes that personal contact would be advantageous to the disposition of this case, he is requested to call the undersigned at his earliest convenience.

Please charge any fee for adding the new claims, and any other fees which may be due, to Deposit Account No. 07-0960.

Respectfully submitted,



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